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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,484	02/18/2005	John Chesney	GFR042US	4502

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Paul Grandinetti  
Levy & Grandinetti  
Suite 408  
1725 K Street, N.W.  
Washington, DC 20006-1419

EXAMINER

VASUDEVA, AJAY

ART UNIT PAPER NUMBER

3617

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,484	<b>Applicant(s)</b> CHESNEY ET AL.	
	<b>Examiner</b> Ajay Vasudeva	<b>Art Unit</b> 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5/24/2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 23 is/are rejected.
- 7) ☒ Claim(s) 9-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Non-Final Rejection*

1. This Office action contains is a non-final rejection based on new grounds. Examiner regrets the resulting inconvenience to the Applicant and his representative

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

- The hydrofoil rotatable on a transverse axis, as set forth in claim 1.

*Note: Applicant is requested to indicate the direction of rotation with an arcuate line having arrows at both ends.*

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

3. Appropriate section headings are missing in the Specification. The following section headings may be provided in the specification:

- a. Title of the Invention.

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- b. Background of the Invention.
  - Field of the Invention.
  - Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- c. Brief Summary of the Invention.
- d. Brief Description of the Several Views of the Drawing(s).
- e. Detailed Description of the Invention.

Applicant is requested to appropriately include the above recommended section headings in the Specification.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- The hydrofoil rotatable on a transverse axis, as set forth in claim 1.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 6 recites "the hydrofoil is controlled manually", while claim 7 recites "the hydrofoil is controlled automatically". However, the original disclosure (the Drawing or the Specification) does not provide adequately description as to how such control mechanism is disposed or how the claimed manual and automatic control is achieved. Therefore, the disclosure would not have allowed one skilled in the art to make and/or use the claimed invention.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Gilruth (US 2,703,063 A).

Gilruth shows a hydrofoil [19] that is rotatable on a transverse axis to provide a variable lift to a craft. It is noted that the claim does not positively recite the hydrofoil as being attached to a craft, and recites the attachment merely as an intended use. Applicant is reminded that any limitation followed by "for" – such as "for use with ..." – is considered to be merely an intended use, and is not accorded any patentable weight in the claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 5, 6, 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieker (US 6,578,506 B2) in view of Pazulski (US 3,238,911 A).

Bieker shows a sailing craft with a mono hull, having a keel (fig. 1) and a hydrofoil [12] rotatable on a transverse axis (fig. 3). The hydrofoil is substantially rectangular shaped (fig. 2), and is manually adjustable between a neutral angle of attack (col. 4, line 41) and a positive angle of attack up to 8 degrees (col. 5, line 2). Bieker also discloses the craft as having an option of power propulsion (see col. 2, line 47).

Bieker, however, does not disclose the sailing craft as having a power propulsion means at the stern.

Pazulski shows a sailing craft with an auxiliary power propulsion means [28] at the stern.

It would have been obvious for one skilled in the art at the time of the invention to provide a power propulsion means at the stern of Bieker, as taught by Pazulski. Having such an arrangement would have allowed the craft to be propelled by an auxiliary propulsion source even when the wind was inadequate to provide primary propulsion to the craft.

Re claim 1, Applicant may note that because the hydrofoil is movable between neutral and positive angles of attack, the hydrofoil is capable of being adjusted to a first position where it would provide no lift to the stern. Similarly, the hydrofoil is capable of being adjusted to a position where it would provide a lift to the stern so as to allow a substantially level trim.

Re claim 2, the Examiner takes Official notice that making the hull in the streamlined shape, as claimed, is notoriously old and well known in the art. It would have been obvious to an

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artisan to provide the claimed shape to the hull of Bieker as it would have improved the hydrodynamic efficiency of the craft.

***Allowable Subject Matter***

11. Claims 9-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments with respect to claims 1, 2, 5-8 and 23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. The prior art made of record in the attached PTO Form 892, but not yet relied upon, is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ajay Vasudeva  
Primary Examiner  
Art Unit 3617

  
AJAY VASUDEVA  
PATENT EXAMINER 8/4/06